



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/053,303

11/07/2001

KangYoon Lee

JP920000395

5802

48233

7590

09/03/2009

SCULLY, SCOTT, MURPHY & PRESSER, P.C.

400 GARDEN CITY PLAZA

SUITE 300

GARDEN CITY, NY 11530

EXAMINER

SHRESTHA, BIJENDRA K

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

09/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/053,303	Applicant(s) LEE ET AL.	
	Examiner BIJENDRA K. SHRESTHA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-21 are presented for examination. Applicant filed an amendment on 02/26/2009 amending claim 1, 3 and 5-7. Examiner withdraws U.S.C. 112, second paragraph rejection in response to Applicant submitting support for corresponding structure in the specification. After careful consideration of applicant's arguments, new grounds of rejections of claims has been established in the instant application as set forth in detail below. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 8, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. These claims are directed towards steps of "managing and storing.....", "presenting", "allowing.....", obtaining...", "collecting....", and "enabling" without including another machine. Since the claims are directed to a process without including another machine, these claims fall within the scope of human intelligence alone, and are non-statutory. The dependent claims 9-14 which depend upon independent claim 8 evidently rejected under 35 U.S.C. 101.

Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, Applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3691

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al., U.S. Patent No. 6,839,687 (reference A in attached PTO-892) in view of Hilt et al., U.S. Patent No. 6,032,133 (reference B in attached PTO-892 and further in view of Poplawski et al., U.S. Pub No. 2003/0208441 (reference C in attached PTO-892)

As per claim 1, Dent et al. teaches a system for performing personal finance management using the internet, the system being connected to a bank server and plurality of electronic bill presentation and payment (“EBPP”) servers over the internet, comprising:

“a processor operable to connect to a bank server and a plurality of EBPP servers over the internet (See figure 2, #30, which illustrates a computer with a processing unit);”

“EBPP configuration unit for managing and storing EBPP connected-related information related to said plurality of EBPP servers” (See figure 2, #32 & #34, which illustrates a computer with memory), “said EBPP configuration unit for managing and storing further for presenting a list of available EBPP servers that allow a user to collect billing information” (See figure 2, #48, and column 5, lines 57-67, which illustrates a bill management application capable of collecting billing information);

“billing information collection unit for collecting billing information data from each of the EBPP servers, said billing information data including an amount to be paid and payment due date” (See figure 1, #24 & #26, which illustrates distributing billing statements via a service center over a network);

“payment-schedule management unit for presenting a payment-schedule based on said bank account information data and said billing information data” (See figure 2, #48, subsections #52, #54, and #56, specifically #54, which illustrates how paying bills will impact the consumer's cashflow);

“payment processing unit for enabling the user to select how and when to pay the bills and forwarding said user's selection on the payment to the bank server for actual transaction” (See figure 2, #48, and column 5, line 57 through column 6, line 13, which illustrates and discusses how bills are managed, including enabling actual payment).

However, Dent et al. does not expressly disclose “account information-receiving unit for automatically obtaining a user's bank account information data from the bank server via a connection to the bank server according to user preference setting.”

Hilt et al. discloses an electronic bill payment system that allows users to pay requisite amounts to merchants (See abstract).

Both Dent et al. and Hilt et al. disclose systems and methods for bill presentment and payment. Hilt et al. expressly discloses a bill pay system where a user's bank account information is automatically obtained from a financial institution based upon a pre-authorization message (See figure 3, and column 9, lines 32-55, which illustrates and discusses automatically obtaining a user's financial information based upon pre-authorization).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dent et al. to included automated retrieval of account information based on user preference settings as taught by Hilt et al. in order to

Art Unit: 3691

combine automated retrieval of personal account information with personal finance management to quickly and efficiently pay bills.

The Dent et al. and Hilt et al. combination discloses the structural elements of the claimed invention, but fails to disclose “said EBPP configuration unit for further allowing the user to select at least one EBPP server from a list,” “said billing information collecting unit for collecting billing information operable to directly obtain the billing information in a pull mode,” and “said billing information collecting unit for collecting further connecting to said plurality of EBPP servers based on the EBPP connection-related information to collect said billing information from said plurality of EBPP servers.”

Poplawski et al. teach said EBPP configuration unit for further allowing the user to select at least one EBPP server from a list,” “said billing information collecting unit for collecting billing information operable to directly obtain the billing information in a pull mode,” and “said billing information collecting unit for collecting further connecting to said plurality of EBPP servers based on the EBPP connection-related information to collect said billing information from said plurality of EBPP servers (Poplawski et al., Fig. 3 , Customer Service Provider (CSP)/Billing Service Provider (BSP) and Fig. 5; where user registers for plurality of billers EBPP through CSP/BSP which enables user to directly pull any billing information from any EBPP by visiting their website through URL provided).

Therefore, it would have been obvious to someone of ordinary skill in the art at the time the invention was made to modify the Dent et al. and Hilt et al. combination to

Art Unit: 3691

include said EBPP configuration unit for further allowing the user to select at least one EBPP server from a list,” “said billing information collecting unit for collecting billing information operable to directly obtain the billing information in a pull mode,” and “said billing information collecting unit for collecting further connecting to said plurality of EBPP servers based on the EBPP connection-related information to collect said billing information from said plurality of EBPP servers as taught by Poplawski et al. in order to combine the know features of bill presentment and payment with a pull mode operation to allow a payer some measure of flexibility and control pf payment enabling to direct contact with plurality of biller (Poplawski et al., paragraph [0007] and [0010]).

As per claim 2, Dent et al. teaches that “user’s selection on the payment can be an immediate account transfer, a reserved account transfer, and automatic account transfer or transfer cancellation of the amount to be paid, from the user’s bank account” (See payment analyzer, figure 2, #56, which illustrates allowing selection of payment depending on the schedule chosen; specifically column 9 & 10, steps 1-6, which discusses viable options if the payment schedule results in a negative balance).

As per claim 3, Dent et al. teaches the “the payment schedule management unit for calculating and presenting an estimated account balance on the payment due date, in advance, assuming that said amount to be paid is transferred from the user’s bank account on the payment due date” (See cashflow analyzer in figure 2, #54, and payment analyzer in figure 2, #56, which illustrates calculating and estimating account balance).

As per claim 4, Dent et al. teaches the “payment-schedule can be displayed on a daily basis, weekly basis, or monthly-basis” (See payment analyzer in figure 2, #56, and column 3, lines 24-30, which illustrates coordinating different payment schedules for a bill payment cycle (e.g. a month)).

As per claim 5, Dent et al. teaches a system and method for performing personal finance management using the internet (See consumer interface unit, figure 1, #28 (1-n), subsection cashflow analyzer, #24, #26, Figure 2, #48, subsections #52, #54, #56, which illustrates containing a user’s bank account information, distributing billing statements via a service center over a network, determining how paying bills will impact the consumer’s cashflow, and enabling a user to manage payment of electronic bills).

However, Dent et al.” does not expressly disclose a “payment processing unit for presenting the payment result received from the bank server to the user

Hilt et al. expressly discloses a payment processing unit for notifying the user of a payment result via a confirmation receipt (See Figure 2, #66, which illustrates a confirmation receipt sent to the consumer following the payment of a bill). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dent et al. to include a means of notifying the user of an electronic bill pay method or system that the payment result was confirmed as taught by Hilt et al. in order to promptly notify a user of a bill payment system that a payment transaction has occurred (See figure 2, #66 and column 6, line 50, which illustrates and discusses the material passing among participants of an electronic bill pay system, including payment confirmation).

As per claim 6, Dent et al. teaches said billing information collecting unit (See Figure 1 #22 and #24, and column 4, line 54, which illustrates and discusses a biller computing unit) comprises:

“ storing the billing information received from said each of the EBPP servers” (See figure 2 #48, and column 5, lines 57-67, bill management unit, which illustrates and discusses, respectively, bill handling and management functions, including receiving and storing billing information).

However, Dent et al. does not expressly disclose a “billing information collection unit for storing user identification information data for each of the EBPP servers.”

Hilt et al. discloses information identifying a biller (See claims 2 & 3, which discuss information identifying a biller and how the information is compared to an account number table or a biller file to determine the biller’s status).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dent et al. to included storing information identifying a bill payer as taught by Hilt et al. in order to combine automated retrieval of personal account information with personal finance management to quickly and efficiently identify the appropriate bill payer with the correct bill.

The Dent et al. and Hilt et al. combination discloses the structural elements of the claimed invention, but fails to disclose a “billing information collection unit for requesting billing information data to each of the EBPP servers using said stored user identification information.”

Poplawski et al. teach billing information collection unit for requesting billing information data to each of the EBPP servers using said stored user identification information (Poplawski et al., Fig. 3 , Customer Service Provider (CSP)/Billing Service Provider (BSP) and Fig. 5; where user registers for plurality of billers EBPP through CSP/BSP which enables user to directly pull any billing information from any EBPP by visiting their website through URL provided).

Therefore, it would have been obvious to someone of ordinary skill in the art at the time the invention was made to modify the Dent et al. and Hilt et al. combination to include billing information collection unit for requesting billing information data to each of the EBPP servers using said stored user identification information by Poplawski et al. in order to combine the known features of bill presentment and payment with a pull mode operation to allow a payer some measure of flexibility and control with payment enabling to direct contact with plurality of biller (Poplawski et al., paragraph [0007] and [0010]).

As per claim 7, which includes the “system alerting the user when said estimated account balance is less than zero” (See cashflow analyzer in figure 2, #54, and payment analyzer in figure 2, #56, which illustrates calculating and estimating account balance; specifically column 9 & 10, steps 1-6, which discusses how the cashflow analyzer optimizes a payment schedule if the result is a negative balance).

Claims 8 recites equivalent limitations to claim 1 and is therefore rejected using the same art and rationale as set forth above.

Claims 9 & 16 recite the equivalent limitations in claim 2 and are therefore rejected using the same art and rationale as set forth above.

Claims 10 & 17 recite the equivalent limitations in claim 3 and are therefore rejected using the same art and rationale as set forth above.

Claims 11 & 18 recite the equivalent limitations in claim 4 and are therefore rejected using the same art and rationale as set forth above.

Claims 12 & 19 recite equivalent limitations in claim 5 and are therefore rejected using the same art and rationale as set forth above.

Claims 13 & 20 recite equivalent limitations in claim 6 and are therefore rejected using the same art and rationale as set forth above.

Claims 14 & 21 recite the equivalent limitations in claim 7 and are therefore rejected using the same art and rationale as set forth above.

As per claim 15, Dent et al. teaches a computer-program product in a computer readable medium for use in a data processing system for performing personal finance management using the internet, the computer program product comprising the program instructions for:

“managing and storing EBPP connected-related information related to said plurality of EBPP servers” (See figure 2, #32 & #34, which illustrates a computer with memory);

“presenting a list of available EBPP servers that allow a user to collect billing information” (See figure 2, #48, and column 5, lines 57-67, which illustrates a bill management application capable of collecting billing information);

“collecting billing information data from each of the EBPP servers, said billing information data including an amount to be paid and payment due date” (See figure 1, #24 & #26, which illustrates distributing billing statements via a service center over a network);

“presenting a payment-schedule based on said bank account information data and said billing information data” (See figure 2, #48, subsections #52, #54, and #56, specifically #54, which illustrates how paying bills will impact the consumer’s cashflow);

“enabling the user to select how and when to pay the bills and forwarding said user’s selection on the payment to the bank server for actual transaction” (See figure 2, #48, and column 5, line 57 through column 6, line 13, which illustrates and discusses how bills are managed, including enabling actual payment);

“analyzing said billing information data in terms of billing items” (See column 6, lines 1-13, which discusses a cashflow analyzer and payment analyzer that allows a user to assess items and analyze how payment impacts a consumer’s cashflow); and

“providing a user’s consumption pattern ratio graphic chart and consumption tendency variation chart” (See figures 6 & 7, and column 8, line 11, through column 9, line 25, which illustrates and discusses a calendar chart indicating a bill payment cycle).

However, Dent et al. does not expressly disclose “obtaining automatically a user’s bank account information data from the bank server via a connection to the bank server according to user preference setting.”

Hilt et al. expressly discloses a bill pay system where a user’s bank account information is automatically obtained from a financial institution based upon a pre-

Art Unit: 3691

authorization message (See figure 3, and column 9, lines 32-55, which illustrates and discusses automatically obtaining a user's financial information based upon pre-authorization).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dent et al. to include automated retrieval of account information based on user preference settings as taught by Hilt et al. in order to combine automated retrieval of personal account information with personal finance management to quickly and efficiently pay bills.

The Dent et al. and Hilt et al. combination discloses the structural elements of the claimed invention, but fails to disclose "allowing the user to select at least one EBPP server from a list," "directly obtain the billing information in a pull mode," and "connecting to said plurality of EBPP servers based on the EBPP connection-related information to collect said billing information from said plurality of EBPP servers."

Poplawski et al. teach said EBPP configuration unit for further allowing the user to select at least one EBPP server from a list," "directly obtain the billing information in a pull mode," and "connecting to said plurality of EBPP servers based on the EBPP connection-related information to collect said billing information from said plurality of EBPP servers (Poplawski et al., Fig. 3, Customer Service Provider (CSP)/Billing Service Provider (BSP) and Fig. 5; where user registers for plurality of billers EBPP through CSP/BSP which enables user to directly pull any billing information from any EBPP by visiting their website through URL provided).

Therefore, it would have been obvious to someone of ordinary skill in the art at the time the invention was made to modify the Dent et al. and Hilt et al. combination to include allowing the user to select at least one EBPP server from a list,” “directly obtain the billing information in a pull mode,” and “connecting to said plurality of EBPP servers based on the EBPP connection-related information to collect said billing information from said plurality of EBPP servers by Poplawski et al. in order to combine the know features of bill presentment and payment with a pull mode operation to allow a payer some measure of flexibility and control of payment enabling to direct contact with plurality of biller (Poplawski et al., paragraph [0007] and [0010]).

Response to Arguments

3. After careful consideration of applicant's arguments, new grounds of rejections of claims has been established in the instant application. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Accordingly, **this action is made Non-Final**.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cahill et al. (U.S. Patent No. 6,535,855) discloses push banking system and method.

Art Unit: 3691

Mason (U.S. Patent No. 7,216,855) discloses disallow payment for E-billing system.

Remington et al. (U.S. 6,968,319) discloses an electronic bill presentment and payment system with bill dispute capabilities.

Simpson et al. (U.S. 6,934,691) disclose a system and method for managing mail/bills through a central location.

Ganesan et al. (U.S. 6,856,974) discloses electronic bill presentment technique with enhanced biller control.

Schutzer (U.S. 6,292,789) disclose a method and system for bill presentment and payment.

Kolling et al. (U.S. 5,920,847) discloses an electronic bill pay system.

Antognini et al. (U.S. 2005/0033690) disclose a system and method for digital bill presentment and payment.

Antognini et al. (U.S. 2002/0023055) discloses a system and method for digital bill presentment and payment.

Hans et al. (U.S. 7,200,575) discloses managing access to digital content.

House et al. (U.S. 6,785,805) discloses a network-based configuration method for systems integration in test, measurement, and automation environments.

Dent et al. (U.S. 2005/0065883) discloses a consumer-based system and method for managing and paying electronic bill statements.

Sharma (U.S. 2004/0167853) discloses integrated systems for electronic bill presentment and payment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571)270-1374. The examiner can normally be reached on M-F 7:30-4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bijendra K. Shrestha/
Patent Examiner, 3691
08/30/2009

Application/Control Number: 10/053,303
Art Unit: 3691

Page 17